

Remarks

Reconsideration of the application is requested. The objection to the drawings and to Claim 16 have been cured hereby. Applicant acknowledges the election.

Substantively, the limitation of now-canceled Claim 17, namely, a cutting device for enlarging an orifice of said central lumen of said appendix, has been moved into Claim 1.

Of relevance to amended Claim 1 is the rejection of Claims 17-21 under 35 U.S.C. §103 as being unpatentable over McClellan, USPN 6,736,822 in view of Griego, USPP 2002/0095168, admitting that McClellan fails to teach a cutting device for enlarging an orifice of the central lumen of an appendix and relying on Griego, figure 1 and paragraphs 16 and 19 for the shortfall.

This is clear legal error for several reasons. First, McClellan is directed to ligating a Fallopian tube. McClellan implies that other structures may be ligated but nowhere describes any ligation procedure that would require cutting tissue. Indeed, cutting the Fallopian tube to which McClellan is directed is contraindicated, since the point is to tie off the tube, not to damage it and certainly not to remove it. Accordingly, while the secondary reference might disclose a cutter, there is no reason to combine a cutter in the Fallopian tube ligation device of McClellan and indeed good reason not to.


Second, the proffered suggestion to combine - to enable tissue to be cut - ignores the fact that McClellan has no reason to cut its Fallopian tube, which is intended to remain *in situ* with its inner passageway constricted to prevent pregnancy. Cutting this tissue as proposed in the rejection would expose the patient to physical injury and, by fenestrating the Fallopian tube, would establish a passageway for the egg to exit the tube, thus defeating the purpose of McClellan and consequently representing an improper modification, *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

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Moreover, the examiner has placed a finding of fact on the written record that a kit for inverting an appendix, as recited in Claim 1, is patentably distinct from a kit for removing an appendix, as recited in withdrawn Claim 26, Office Action, page 2. But rejecting a combination of structure that includes elements for cutting tissue and, hence, useful for removing it based on a reference that removes nothing contradicts this finding of fact and, hence, is reversible for relying on mutually inconsistent factual findings.

Respectfully submitted,



John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

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